

REMARKS

Claims 1, 2, 9, 11-13, 31, and 34 - 36 are pending in the case, of which Claims 1, 9, 31, and 35 are independent claims. Claims 35 and 36 read on at least Species A (Fig. 1) as defined in the Restriction Requirement of December 14, 2004. Claims 3-8, 10, 14-30, 32, and 33 have been cancelled. Favorable reconsideration of the application, as amended, is respectfully requested.

Applicant appreciates the Examiner's consideration in providing time for Applicant to correct the omitted commentary on how new Claims 35 and 36 define over the previously cited prior art. Applicant also very much appreciates the time the Examiner took to provide initial feedback on the January 30, 2006 Amendment. Based on the Examiner's comments, Applicant has further amended some of the pending claims to further clarify the claimed invention and thereby advance the prosecution of this application.

Paragraph 1 of "Response to Amendment"

The Examiner indicted that the previous amendment was not fully responsive to the prior Office Action, for failing to point out how the newly added claims (Claims 35 and 36) define over the prior art.

Claim 35 recites a first hydraulic brake module, including a first body, a pump, and a fluid separator unit. Claim 35 also recites a hydraulic brake module. Claim 35 further recites a second hydraulic brake module including a second body, separate from said first body, and components, including an ABS pump and at least one ABS valve, mounted on said second body providing antilock braking functions for a wheel brake. Note that the pump of the first hydraulic module is not needed to perform ABS functions, as the brake system has a separate second hydraulic brake module that provides ABS function (anti-lock braking functions). The first hydraulic module is a source of pressurized fluid to pressurize fluid supplied to wheel brakes (through the

ABS unit). The first hydraulic module does not perform ABS function, which are instead performed by the separate second hydraulic brake module.

Such an arrangement is not taught or suggested by the cited prior art (Campau et al. '608, Arwine et al, Tanaka et al and Ganzel '582). Campau et al. '608 discloses an EHB system in which the normal supply (including the pump 42, and various control valves 51 a, b, c, and d) provide normal braking *and* ABS functions of pressure release and reapply (see col. 12, line 51 - col. 13, line 54); thus the claimed arrangement of separate hydraulic modules, one providing normal braking pressure, and the other providing ABS functions, as recited in Claim 35, is not taught or suggested.

Furthermore, in an earlier action (mailed April 7, 2005), the Examiner asserted that the references show a second brake module, citing Campau et. al. '608 brake module at 10, Arwine et al. modules at 26 and 78, Ganzel '582 plurality of modules in columns 1 and 2, and Tanaka et al. in figure 1 at elements 21-24, and 37 (Office Action, page 6, first paragraph.) However, as Applicant pointed out in the Amendments dated June 7, 2005 and October 7, 2005, the various modules referred referenced by the Examiner were electronic control modules, not brake modules as claimed by Applicant. Thus, the claimed arrangement of separate hydraulic modules, one providing normal braking pressure, and the other providing ABS functions, as recited in Claim 35, is not taught or suggested.

Claim 36 depends from Claim 35 and thus defines over the prior art for the same reason. Additionally, Claim 36 recites a second relief valve (in addition to a first relief valve in the first hydraulic module) providing overpressure protection in the second hydraulic module. Such an arrangement is also not shown in the cited prior art.

Paragraph 2 of "Response to Amendment"

The Examiner remarked that in the last Amendment, Applicant was attempting to make a distinction between electronic control modules and brake modules. The Examiner is correct: Applicant is trying to distinguish between electronic control

modules (i.e., modules having only electronic and electrical components) and brake modules (modules having hydraulic components such as pumps, valves, fluid separators, and fluid passageways or conduits...though some of the components may be electrically operated (such as valves or motor-operated pumps) or otherwise have an electronic aspect -such as pressure sensors; though pressure sensors are not specifically claimed, brake modules according to the claims may contain pressure sensors and other similarly hydraulic components having some electronic aspect). To make this distinction clearer, Applicant has amended the claims to add the adjective "hydraulic" to the term "brake modules", thereby rendering moot the Examiner's argument that any electronic control module may be interpreted as a brake module.

The Examiner also remarked, with respect to Claim 1, that Applicant is claiming only "a brake module (singular) not modules." The Examiner is, again, absolutely correct in this part of his statement; Claim 1 is directed to an individual hydraulic brake module that can be added to an existing brake system (albeit, a brake system of a particular type, as spelled out in the preamble). However, contrary to the Examiner's assertion, the Applicant does not claim a wheel brake actuator as part of the claimed module. In Claim 1, Applicant is not claiming the brake system recited in the preamble, but rather claiming a single module, formed of a body with various specific features and components formed therein or mounted thereon. In submitting Claim 1, Applicant is seeking, for the duration of the patent, rights granted under U.S. Patent laws, including the exclusive right to make, use, sell, or import the claimed module. In Claim 1, applicant is not seeking to restrict others from making, using, etc., brake systems in which the module claimed in Claim 1 may be used. However, Applicant does seek, for example, the exclusive right to produce the claimed module which others may purchase to easily improve operation of their pre-existing brake systems. This will allow, for example, automobile manufacturers to offer vehicles with two types of brake systems, with varying features and price points, by simply adding (or not) Applicant's module to the basic brake system during manufacture.

The Examiner remarked that Applicant's analysis of Panduit vs. Dennison Manufacturing Co., 1 USPQ 2d 1593, 1597 (Fed. Cir. 1987) "would seem to indicate that no parts of any type of prior art mechanical system may be interchangeable." While during prosecution of patent applications Applicant's attorney often wishes this were the case, the rule in Panduit is not quite so restrictive. Nevertheless, the rule is that the prior art as a whole must suggest the combination claimed in the application; and "hindsight reconstruction from similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under 35 U.S.C. 103." *Panduit* at 1603, citing, *Akzo N. V. v. International Trade Commission*, 1 U.S.P.Q.2d 1241, 1246 (Fed. Cir. 1986), and *W.L. Gore & Associates, Inc. v. Garlock*, 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 461 (1984).¹

The rejection in the previous Office Action appears to have treated all the references that contain any mention of the components proportion valve or control module as interchangeable. There is no showing by the Examiner that the references themselves, as a whole, suggest the combinations claimed by the Applicant. Just because mechanical components in the prior art may be interchanged does not mean that there is a suggestion in the prior art that they may be interchanged. Applicant appreciates the difficulty that an Examiner may have in avoiding inadvertent hindsight reconstruction of the components of an invention, but fails to see how the combination of references assembled by the Examiner suggest, in themselves, the interchange of components put forth by the Examiner to arrive at the claimed combinations.

Finally, the Examiner comments that some of the independent claim limitations were narrowed while adding "broader" claims such as 35 and 36, and states that this will not help to advance the prosecution of the case. Applicant appreciates the Examiner's position, and is earnestly trying to advance the prosecution of the case toward issuance of a patent. However, the Examiner must appreciate in return that

¹ See also, *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984); *Carella v. Starlight Archery, Inc.*, 231 U.S.P.Q. 644, 647 (Fed. Cir. 1986); and *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

Applicant not only desires to receive a patent; Applicant desires to receive a patent having claims that adequately encompass Applicant's invention. As the Examiner and Applicant's undersigned Attorney are well aware, reissue of patents to claim subject matter that was inadvertently not claimed in a patent prior to issue can be an immensely difficult, protracted, and expensive process, full of pitfalls and difficulties for both the applicant(s) and the examiner. Accordingly, Applicant wishes to avoid such a process by "getting the claims right" during the current prosecution (for example, in Claim 31, by extending the list of functions that may be provided by the second hydraulic brake module to include all those discussed on page 14 of the application) as soon as a problem is recognized.

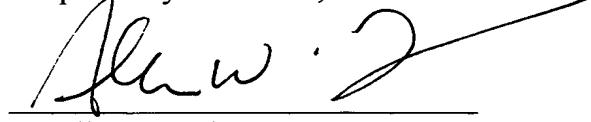
In any case, as discussed above, Applicant believes that Claims 35 and 36 clearly define over the prior art, and were not as overly broad as to be disruptive to the course of prosecution. Furthermore, in this amendment Applicants have further amended each of the independent claims, including Claim 35, to clarify the scope of the claims and to better define over the prior art. Applicant believes that all the claims, as now amended, now clearly define over the prior art, allowing the Examiner to bring prosecution to a rapid close by issuing a Notice of Allowance.

Appl. No. 10/827,057
Amendment dated May 19, 2006
Reply to Office Action of April 19, 2006

Concluding Remarks

In view of the foregoing amendment and remarks, all pending claims are in condition for allowance. Favorable action is respectfully solicited.

Respectfully submitted,



Allen W. Inks
Reg. No. 37,358

MacMillan, Sobanski & Todd, LLC
One Maritime Plaza, Fifth Floor
720 Water Street
Toledo, Ohio 43604
Tel: 734-542-0900
Cell Phone: 419-260-4657
Fax: 734-542-9569